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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,211	09/15/2004	Miki Murakami	257809US6PCT	1806
22850 7590 11/16/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WINTER, JOHN M				
ART UNIT 3685		PAPER NUMBER		
NOTIFICATION DATE 11/16/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/507,211

**Applicant(s)**

MURAKAMI ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on July 30, 2009 is hereby acknowledged. Claims 1-9 and 11 remain pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

5. In this particular case, claim 9 fails prong (1) because the “tie” (e.g. downloading content) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 1 and 8 are the claimed invention is directed to non-statutory subject matter.

Claims 1 and 8 state “a content delivery system” and “an information processing apparatus” respectively, however in the body of the claim, features such as “registering means” and license granting mean” are described in the specification (at page 21) as “executable client applications” and therefore the elements of the claimed invention are directed towards “software per se” and as such are non-statutory.

6. Claims 2-7 are dependant upon claim 1 and are rejected for at least the same reasons.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 1 recites "second license granting means which, after said user has moved the acquired content from said requesting one client to another client of the same user, issues said another client, from a second content providing means, a second license for the moved acquired content." It is unclear how the "second license granting means .." is further modified by a structure (i.e. "a second content providing means..."). Claims 2-7 are dependant upon claim 1 and are rejected for at least the same reasons.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US Patent 5,629,980) in view of Cooper et al (US Patent 5,563,946) and further in view of Horstmann (US Patent 6,009,401).

10. As per claims 1, 8, 9 and 11

Stefik et al. ('980) discloses a content delivery system for delivering content to a client of a user who possesses at least two clients, each of said clients using content based on an acquired license, said content delivery system comprising:

customer-related information managing means for managing said customer-related information; first content providing means which, in response to a request from any one of said clients, provides content to the requesting client; (Figure 18, Column 11, lines 1-14 – description of "work state information"),

first license granting means which, in response to a request from the requesting client having acquired the content from said first content providing means, grants issues said requesting client a first license for the acquired content; (Column 9, line 7 – Discussion of "Structure of digital works")

11. Stefik et al. ('980) does not explicitly disclose "registering means for registering each of said clients of said user in order to acquire customer-related information;

Cooper et al. ('946) discloses "registering means for registering each of said clients of said user in order to acquire customer-related information" (Figure 9) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Stefik et al. ('980) method with the Cooper et al. ('946) method in order to keep a persistent record of clients.

Stefik et al. ('980) does not explicitly disclose "second license granting means which, after said user has moved the acquired content from said requesting one client to another

client of the same user, issues said another client, from a second content providing means, a second license for the moved acquired content.” Horstmann. (‘401)discloses “second license granting means which, after said user has moved the acquired content from said requesting one client to another client of the same user, issues said another client, from a second content providing means, a second license for the moved acquired content“ (Figure 3, column 4 line 52- column 4 line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Stefik et al. (‘980) method with the Horstmann. (‘401) method in order to increase the value of the license by allowing it’s reuse.

Examiner notes that in regard to claim 11, it would be obvious to one of ordinary skill in the art that the re-licensing process as disclosed by Horstmann would involve a second “CPU” and a second “storage media” separate and discreet from the first licensing entity.

12. As per Claim 2,

Stefik et al. (‘980) discloses a content delivery system according to claim 1, wherein said customer-related information managing means manages a table of correspondences between leaf ID's and client ID's, a table of correspondences between client ID's and user ID's, a table of correspondences between content ID's and license ID's, a table of correspondences between user ID's and the content ID's of downloaded content, and a table of correspondences between user ID's and license ID's of downloaded licenses.(Figures 14 and 15)

13. As per Claim 3,

Stefik et al. ('980) discloses a content delivery system according to claim 1, wherein said customer-related information managing means updates said customer-related information when said content providing means provides content to a client or when any one of said first and said second license granting means grants a license to a client. (Column 35, lines 30-60 -- Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted. )

14. As per Claim 4,

Stefik et al. ('980) discloses a content delivery system according to claim 1, Stefik et al. ('980) does not explicitly disclose "wherein, in response to a request from said another client for a license, said second license granting means acquires a second license from said first license granting means and returns the second license to said another requesting client." Horstmann. ('401) discloses "wherein, in response to a request from said another client for a license, said second license granting means acquires a second license from said first license granting means and returns the second license to said another requesting client. " (Figure 3, column 4 line 52- column 4 line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to



combine the Stefik et al. ('980) method with the Horstmann. ('401) method in order to increase the value of the license by allowing it's reuse.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

15. As per Claim 5,

Stefik et al. ('980) discloses a content delivery system according to claim 4, Stefik et al. ('980) does not explicitly disclose "wherein said second license granting means, by querying said customer-related information managing means, verifies that said another requesting client is authorized to receive content, that the user of said another requesting client is the same user of another client registered with said first license granting means, and that the requested license has already been granted to said another client by said first license granting means." Horstmann. ('401)discloses "wherein said second license granting means, by querying said customer-related information managing means, verifies that said another requesting client is authorized to receive content, that the user of said another requesting client is the same user of another client registered with said first license granting means, and that the requested license has already been granted to said another client by said first license granting means" (Figure 3, column 4

line 52- column 4 line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Stefik et al. ('980) method with the Horstmann. ('401) method in order to increase the value of the license by allowing it's reuse.

16. As per Claim 6,

Stefik et al. ('980) discloses a content delivery system according to claim 1 further comprising fee-charging means for performing a fee-charging process regarding the client to which a first or second license has been issued. (Figure 15)

17. As per Claim 7,

Stefik et al. ('980) discloses a content delivery system according to claim 5 wherein said fee-charging means charges a first fee when said first license granting means issues grants a first license to said requesting client, and charges a second fee when a case in said second license granting means grants issues a second license to said another client of the same user client.(Figure 15)

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim

because they can always be omitted.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685